

REMARKS

Claims 1-14 are all the claims pending in the application. By this Amendment, Applicant amends claims 1 and 8. Claims 1 and 8 have been amended solely for the purpose of correcting minor error. Since such amendments are made to correct minor, basic elements, Applicant respectfully submits that they do not narrow the scope of the claim and do not raise any Festo implications.

Preliminary Remarks

The Examiner reminds the Applicant that it is Applicant's responsibility to ensure that the drawings are corrected in accordance with instructions set forth in the previous office action of April 30, 2003. Applicant thanks the Examiner for the reminder. However, Applicant respectfully submits that the drawings filed on September 20, 2000 are accepted as indicated in the present office action, PTO form PTOL-326 and the previous office action of April 30, 2003. Therefore, this reminder is inapplicable to the present application.

Rejection under 112

In addition, the Examiner rejected claims 1-5 and 8 under section 112, second paragraph for including phrase "such as" in claims 1 and 8. Applicant thanks the Examiner for pointing out, with particularity, aspects of the claim thought to be indefinite. Applicant respectfully requests the Examiner to withdraw this rejection in view of the self-explanatory claim amendments, being made to claims 1 and 8, herein.

Rejection under 103(a)

The Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over USP 6,449,272 to Chuah et al. (hereinafter “Chuah”) in lieu of obviousness. Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider this rejection in view of the comments, which follow. Of these rejected claims, claims 1, 6, 8 and 10-13 are independent. Applicant will first address this rejection with respect to claim 1.

Independent claim 1 recites a novel combination of features. For example, claim 1 recites: *...notifying said second user-terminal based on said request of communication from said first user terminal; and switching said second user terminal from said second virtual private network to said first virtual private network...* From hereinafter, this recited limitation will be referred to as “switching to a different virtual private network the user terminal to which a request is made” for the sake of linguistic convenience only.

The Examiner asserts that claim 1 is directed to a method of connecting a first user terminal of a first virtual private network to a second user terminal of the second virtual private network and is obvious in view of Chuah. The Examiner asserts that Chuah’s switching ISP providers (serving LACs) for a PC renders obvious switching a user terminal to which a request for connection has been made, to a different virtual private network as set forth in claim 1 (see pages 3-4 of the Office Action). Applicant respectfully disagrees with the Examiner. Applicant has carefully studied Chuah’s discussion of establishing a connection with a VPN via anchor LAC and the hand-off procedure (switching to a different serving LAC), which does not teach or

even remotely suggest switching to a different virtual private network the user terminal to which a request is made as set forth in claim 1.

For example, an illustrative, non-limiting embodiment of the present invention teaches switching a user terminal from a first virtual private network ("VPN") to a second VPN by using information stored in the subscriber server data. The subscriber data server (SDS) receives requests to connect to a second user terminal from the first user terminal via network access server (NAS), searches in the database for the recent registration information of the second user terminal. In particular, it checks to see which NAS is connected to the second terminal and to which VPN the second terminal belongs. Then, it notifies the second user terminal about the incoming call. The second user terminal decides whether to accept the call or not. If this second terminal decides to accept the call, it is switched to the VPN of the first user terminal; thereby, allowing the first user terminal to access the second user terminal via VPN. Finally, the registration information in the SDS is updated.

On the other hand, Chuah teaches a method of switching remote user to a different Internet Service Provider (ISP) without losing previously established VPN connection (col. 1, line 55 to col. 2, line 12). In particular, Chuah teaches a remote user initiating a point to point connection to the serving LAC (NAS) in ISP B. ISP B authenticates the user and accepts the connection (Fig. 2; col. 3, lines 50 to 65). Next, in order to establish the VPN, the serving LAC checks its VPN table which has an association between users and anchor LACs (another NAS) and identifies anchor LAC associated with this user. Once the anchor LAC is identified, a tunnel

is established between the service LAC and the anchor LAC provided there are no existing tunnels between the two LACs (Fig. 2; col. 4, lines 12 to 60).

Once the tunnel is established, serving LAC forwards a VPN request along with user information to the anchor LAC. Anchor LAC identifies the associated LNS (corporate network server that provides VPN) and establishes a VPN session (Fig. 3; col. 4, line 65 to col. 5, line 62). This multi-hopping technique is especially beneficial for establishing VPN from a cellular phone (its location may change to a different geographical area; thereby, resulting in a VPN session being drop). Specifically, PCS wireless network detects the need for a hand-off and provides the new LAC with a notification of an impending hand-off. The new LAC identifies the anchor LAC, establishes the connection with the anchor LAC and sends a continued call request message to the anchor LAC. The anchor LAC recovers information about the terminal and its connection to the VPN network; thereby, allowing the transfer of the existing connection to the new LAC (Fig. 10; col. 9, line 33 to col. 10, line 48).

To sum up, Chuah teaches having a serving LAC and an anchor LAC, which stores information about VPN sessions. If a switch of serving LACs needs to be made, the new serving LAC identifies the anchor LAC to get information about the current session and establishes a link to the current session. As a result, this arrangement prevents the drop off of the VPN connection (instead the connection is continued through a new serving LAC).

However, in Chuah, there is only one VPN. That is, Chuah teaches maintaining the same VPN while changing ISPs. In particular, Chuah teaches switching ISPs to maintain a link to the

same VPN. Although one tunnel, the tunnel from a serving LAC to an anchor LAC; is changed, the tunnel from the anchor LAC to the VPN is the same.

The purpose of Chuah is to maintain access to the same information (same VPN network). Although, as asserted by the Examiner, the sessions may have changed (switch from one ISP to another), switching sessions (tunnel between ISP and the anchor server) cannot be similar or in any way suggest switching VPNs. Chuah fails to teach or suggest switching from one VPN to another. Such a switch results in complete informational lost with respect to the old VPN. In other words, the information accessed, after the switch occurs, is completely different (new VPN).

In short, the functionality and the result of the switch from one ISP to another ISP is completely different from switching between VPNs. In Chuah, when switching between ISPs (geographical location has changed), the function is to maintain connection for that terminal; the purpose of Chuah's switch is to maintain connection to the same VPN, to avoid the drop off. In contrast, the function of switching VPNs is to change connections (log on to a new network) and the purpose is to provide the user with different information available on a different VPN. In other words, Chuah attempts to maintain access to the same information, and not switch (force a disconnect from the previous VPN) to a new VPN. As such, Chuah fails to teach or even remotely suggest a switch from a second VPN to the first VPN.

In addition, Chuah teaches that the serving LAC notifies anchor LAC that it wants to connect to VPN and the anchor LAC in turn identifies the LNS of the requested VPN and

notifies the LNS of the new dial up session. The LNS either accepts or rejects the connection and responds to anchor LAC, which in turn relays it to the serving LAC. However, in Chuah, it is the serving LAC that is connected to the LNS via anchor LAC. Nothing is being done to the LNS to establish the connection with the serving LAC. Chuah only teaches the serving LAC sending messages to the anchor LAC and the anchor LAC sending messages to the LNS and visa versa via same chain.

In short, Chuah fails to teach or suggest changing the configuration of the LNS (one receiving the request) to the configuration of the requester. Applicant respectfully points out that Chuah fails to teach or suggest switching the second terminal, which received a request for a connection. To sum up, Chuah only deals with one VPN. As a result, it fails to teach or suggest switching the second terminal or PC to a different VPN so that the first terminal or PC would access information on this second terminal.

Therefore, switching to a different virtual private network the user terminal to which a request is made, as set forth in claim 1 is not suggested or taught by Chuah, which lacks switching to a second VPN and switching the terminal which received a request for connection, as opposed to switching the requesting terminal. For at least these reasons, Applicant respectfully submits that independent claim 1 is not rendered obvious by Chuah. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 1. Also, Applicant respectfully submits that claims 2-5 and 14 are allowable at least by virtue of their dependency on claim 1.

With regard to the independent claims 6, 8 and 10-13, in each, there is some requirement relating to switching over the VPN of the user terminal. Applicant has already demonstrated that Chuah does not teach or suggest such a function or feature. Therefore, in view of Chuah, an artisan of ordinary skill would not have (and could not have) produced the subject matter of any of these independent claims. Applicant, therefore, respectfully requests the Examiner to allow claims 6, 8 and 10-13. Claims 7 and 9 are patentable at least by virtue of their dependency on claim 6.

Improper Finality

A Non Final Office Action issued April 30, 2003, in the above-identified application, in which claims 1-13 were rejected. Applicant filed an Amendment on July 30, 2003 (hereinafter "Amendment"), amending claims 1-13 for improved conformity with US practice and improved clarity and adding claim 14, which did not necessitate additional searches for the Examiner. In fact, on page 15 of the Amendment, Applicant explained that "the claim amendments are made solely for the purpose of improved readability and conformance with U.S. practice". In short, Applicant's response did not (and could not) necessitate the new grounds for rejection of claims 1-13. See MPEP § 706.07(a) which states:

that a second or any subsequent action on the merits shall be final, **except** where the Examiner introduces a new ground for rejection that is: (1) not necessitated by an applicant's amendment of the claims or (2) based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c).

In this Office Action dated April 30, 2003 (hereinafter "Office Action"), the Examiner indicated that claims 1-13 are rejected. However, the Examiner indicated that Applicant's arguments with respect to claims 1-13 have been considered but are moot "in view of the new grounds for rejection" (see page 2 of the Office Action). Specifically, in this Office Action, the Examiner rejected claims 1-14 using Chuah, only, as opposed to the previous Office Action dated April 30, 2003, where the Examiner rejected claims 1-13 using Alonso and Chen. In short, in this Office Action, the Examiner provided one new reference, which was not previously made of record.

Therefore, maintaining a final rejection where new rejections are made in the absence of substantive amendments to the claims by the Applicant, is improper. *The improper finality of the Office Action robs the Applicant of the opportunity to respond by amending the claims as of right in the face of prior art references that should have been made of record by the Examiner in the first Office Action.* In view thereof, Applicant respectfully requests the Examiner to withdraw the finality of the Office Action and reopen prosecution for the reason that Applicant's Response under 37 C.F.R. § 1.111 filed July 30, 2003, did **not** necessitate the new grounds of rejection.

Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Response Under 37 C.F.R. § 1.116
U.S. Application No. 09/666,388

Attorney Docket No.: Q60803

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kelly G. Hyndman
Registration No. 39,234

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 27, 2004